

REMARKS/ARGUMENTS

This amendment is responsive to the Office Action that issued May 5, 2005. In light of the following remarks, reconsideration and removal of the grounds for rejection are respectfully requested. Claims 1-14 are pending in this Patent Application. Claims 1 and 8 are independent claims.

Claims 1-7 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Publication No. 2002/0122057 to Maloney, ("Maloney") in view of the publication by Clunie, entitled, "DICOM SR Meets XML" and "SR Object Model (SR_OM)", NEMA SR Workshop (pages 1-22, March 29-30 2000), (hereinafter "Clunie") in further view of U.S. Patent No. 6,732,330 to Claussen ("Claussen"). Claim 8 is rejected under 35 U.S.C. §103(a) as unpatentable over Clunie. Claims 9-11 are rejected under 35 U.S.C. §103(a) as unpatentable over Clunie in view of Claussen. Claims 12-14 are rejected under 35 U.S.C. §103(a) as unpatentable over Clunie in view of Claussen in further view of Maloney.

In response, to the 35 U.S.C. §103(a) rejections, Applicants provide the following remarks together with a Philips Research restricted access report by Kwok Pun Lee and Jingkun

Hu, the Applicants, entitled "A Translator for Structured Reports from DICOM Binary Format to XML Format", (hereinafter "Exhibit B" as previously included in the Amendment submitted on September 29, 2004); and two (2) Declarations under 37 C.F.R. §1.131 included in Appendixes A and B herein in support of Exhibit B. Exhibit B together with the 37 C.F.R. §1.131 Declarations clearly show a reduction to practice of the inventions protected by the currently pending claims prior to the March 2, 2001 filing date of Maloney.

Applicants proffer the Declaration of Kwok Pun Lee (included herein Appendix A) pursuant to 37 C.F.R. §1.131; the Declaration of Jingkun Hu (included herein Appendix B) pursuant to 37 C.F.R. §1.131; together with the previously submitted Exhibit B and respectfully submit that together these documents obviate Maloney and thus the rejections under 35 U.S.C. §103.

Exhibit B evidences that Kwok Pun Lee and Jingkun Hu constructed an embodiment thereby, performing the process that meets every element of pending Claims 1-14 and that operated for its intended purposes prior to the filing date of Maloney. The activity contributing to this reduction to practice was conducted by Kwok Pun Lee, Jingkun Hu, and/or technicians

working under Kwok Pun Lee's and/or Jingkun Hu's direct supervision and control prior to the filing of Maloney.

The reduction to practice evidenced by Exhibit B consists of a description for an actual constructed translator for structured reports from DICOM binary format to Extensible Markup Language (XML) format (hereinafter, the "DICOM-to-XML Translator") that fully supports each of Claims 1-14. Exhibit B and the DICOM-to-XML Translator were not available to the public. Exhibit B was utilized as the basis for the preparation of United States Patent Application Serial No. 09/818,715. The Applicants respectfully submit that Exhibit B clearly describes the results of an actual translator that was built to validate the DICOM to XML conversion. The (emphasis provided) "document describes the application scenario, design, and implementation of the DICOM2XML translator." (See, Exhibit B, page 3, lines 22-23.)

For example, Exhibit B, page 3, lines 18-19 clearly states that (emphasis provided) "[w]e have implemented a translator, called DICOM2XML, which takes a structured report in DICOM binary format and produces an XML document." Section 3 of Exhibit B titled "Design Decisions" describe two exemplary

translators and correspond in fact to the translators shown in FIGs. 1 and 2 of the '715 patent Application. Exhibit B on page 5, second paragraph, states "we selected the second approach" for implementing the DICOM-to-XML Translator. Other elements of the implemented DICOM-to-XML Translator are described on page 6, lines 5-6 including selection of an XML parser, Xerces version 1.1 from Apache Software Foundation. Figure 4 of Exhibit B directly corresponds to FIG. 2 of the '715 Patent Application. Exhibit B, Sections 6 and 7 describes in detail the Implementation of the DICOM-to-XML Translator including the mapping rules for the translation and the XSL Stylesheet used. Section 8 sets out that the DICOM-to-XML Translator coupled to an XML-to-DICOM translator produced a match to the originally input DICOM document. In other words, the implementation produced an XML result that was verified by translating the result of the DICOM-to-XML Translator back into DICOM. Accordingly, it is clear that the built and described DICOM-to-XML Translator worked for its intended purpose.

The description itself contained in Exhibit B is sufficient to enable a person of ordinary skill in the art to also implement the DICOM-to-XML Translator without requiring undue

experimentation and therefore is clear evidence of a reduction to practice.

Exhibit B fully supports the claimed invention for example as required by Claim 1 including "[a] method for mapping a DICOM-SR document into an XML document" as for example shown in Exhibit B, Figures 1 and 2. Further "mapping each DICOM attribute of a plurality of DICOM attributes in the DICOM-SR document into a corresponding XML element of a plurality of XML elements" is illustratively shown in Exhibit B, Section 6, subparagraph 6. Further still, "outputting each XML element of the plurality of XML elements to the XML document, in a format that conforms to an XML document-type-definition of the XML document" is illustratively shown in Exhibit B, Section 7 through the use of SR XSL Style Sheets. Similarly, the elements of the other claims are well supported by the illustrative embodiment shown in Exhibit B as evidenced by the Declarations of Kwok Pun Lee and Jingkun Hu.

The MPEP under §2138.05 entitled "Reduction to Practice" makes clear that "a party seeking to establish an actual reduction to practice must satisfy a two-prong test: (1) the party constructed an embodiment or performed a process that met

every element of the interference count, and (2) the embodiment or process operated for its intended purpose." *Eaton v. Evans*, 204 F.3d 1094, 1097, 53 USPQ2d 1696, 1698, (Fed. Cir. 2000). Further, "an actual reduction to practice ... requires a showing of the invention in a physical or tangible form that shows every element of the count. *Wetmore v. Quick*, 536 F.2d 937, 942, 190 USPQ 223, 227 (CCPA 1976). For an actual reduction to practice, the invention must have been sufficiently tested to demonstrate that it will work for its intended purpose ... If a device is so simple, and its purpose and efficacy so obvious, construction alone is sufficient to demonstrate workability. *King Instrument Corp. v. Otari Corp.*, 767 F.2d 853, 860, 226 USPQ 402, 407 (Fed. Cir. 1985)."

"A process is reduced to practice when it is successfully performed ..." 1928 C.D. at 262-263; *Fitzgerald v. Arbib*, 268 F.2d 763, 765-66, 122 USPQ 530, 531-32 (CCPA 1959).

It is respectfully submitted that Exhibit B together with the Declarations contained herein provides substantial evidence and clearly demonstrates that the DICOM-to-XML Translator was constructed, met every element of the currently pending claims,

and operated for its intended purpose prior to the filing date of Maloney.

Accordingly, Applicants' respectfully submit that the §1.131 Declarations and Exhibit B evidence a prior reduction to practice of the teachings of Maloney. Thus, it is respectfully submitted that the 35 U.S.C. §103(a) rejections are overcome. In light of the substantial evidence contained herein, it is respectfully requested that the 35 U.S.C. §103(a) rejections be withdrawn.

The Applicant's have made a diligent and sincere effort to place this application in condition for immediate allowance and notice to this effect is earnestly solicited.

Respectfully submitted,

By Gregory L. Thorne

Gregory L. Thorne, Reg. 39,398
Attorney for Applicant(s)
August 25, 2005

Enclosure: Appendix A: §1.131 Declaration of Kwok Pun Lee
Appendix B: §1.131 Declaration of Jingkun Hu

THORNE & HALAJIAN, LLP
Applied Technology Center
111 West Main Street
Bay Shore, NY 11706
Tel: (631) 665-5139
Fax: (631) 665-5101

CERTIFICATE OF MAILING

It is hereby certified that this correspondence is being deposited with the United States Postal Service as first-class mail in an envelope addressed to:

COMMISSIONER FOR PATENTS

P.O. BOX 1450

ALEXANDRIA, VA 22313-1450

On August 25, 2005
(Date of Mailing)

By Gregory L. Thorne